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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/549,772	09/19/2005	Derek Michael Auret	10338-22US (12553300ALC)	7881
570	7590	11/23/2007	EXAMINER	
AKIN GUMP STRAUSS HAUER & FELD L.L.P. ONE COMMERCE SQUARE 2005 MARKET STREET, SUITE 2200 PHILADELPHIA, PA 19103			KENNEDY, JOSHUA T	
		ART UNIT		PAPER NUMBER
		3679		
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		11/23/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)
	10/549,772	AURET, DEREK MICHAEL
	Examiner	Art Unit
	Joshua T. Kennedy	3679 

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 18 October 2007.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1,3,6,7,9-13 and 24-29 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1, 3, 6-7, 9-13 and 24-29 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) Notice of Informal Patent Application
- 6) Other: _____

DETAILED ACTION

Election/Restrictions

Examiner notes that a further election of species requirement is not proper at this time since no mutually exclusive claims have been presented. In this regard, it should be noted that the claims are drawn to the panel of the fence having deformed portions of pickets per se. Should the claimed invention begin to separately define the various species, applicant should note that the propriety of an election requirement will be revisited at that time. Note MPEP 811.

Claims 1, 3, 6-7, 9-13 and 24-29 have been examined.

Claims 2, 4, 5, 8 and 14-23 have been cancelled.

Claim Rejections - 35 USC § 102

Claims 1, 3, 6, 7, 9-13, 25, 26 and 28 are rejected under 35 U.S.C. 102(b) as being anticipated by Souza, Jr. (US Patent 3,357,681).

As to Claim 1. Souza, Jr. discloses a panel (Fig 1) for a fence having at least one hollow rail (16) and a plurality of pickets (31) supported by the rail, wherein each picket passes through two apertures in the rail (Fig 14; Examiner considers the first aperture to be the elongated aperture defined by the rail body 16 and the second aperture to be the holes 22. When assembled, the picket is located between both apertures), and a

portion (33) of each picket located inside of the rail between the apertures is deformed to thereby prevent further passage of the pickets through apertures (Col 3, Lines 59-62).

It is noted that the method as to how the pickets are deformed and the time in which the pickets are deformed impart no additional structural limitations to the claimed structure. The specific method of forming is not germane to the issue of patentability of the device itself. See MPEP § 2113.

As to Claim 3. Souza, Jr. discloses the portion (33) of each picket that has been deformed within the rail has a partly flattened shape that no longer matches the shape of the respective apertures in the rail (Fig 14; Col 3, Lines 59-62).

As to Claim 6. Souza, Jr. discloses each picket passing through only one side of the rail and ending at an internal wall (20) within the rail, an end portion of the picket being held in a wall aperture (22) of the internal wall (Fig 14).

As to Claim 7. Souza, Jr. discloses a panel for a fence having at least one hollow rail (16) and a plurality of pickets (31) supported by the rail, wherein the rail has an external rail (16) with entry apertures for the pickets (Fig 3), and internal wall (20) for holding end portions of the pickets, and wherein each picket enters the rail through a respective entry aperture and has an end portion which is held by a corresponding holding aperture in the internal wall (Fig 14).

As to Claim 9. Souza, Jr. discloses the holding apertures being aligned with the entry apertures so that the pickets are perpendicular to the rail (Fig 14).

As to Claim 10. Souza, Jr. discloses the holding apertures are aligned with the entry apertures so that the pickets are not perpendicular to the rail (Col 2, Lines 7-14).

As to Claim 11. Souza, Jr. discloses the internal wall (20) being moveable within the rail to vary the alignment of the holding apertures and the entry apertures.

As to Claim 12. Souza, Jr. discloses the holding apertures (22) being formed by a plurality of flanges which receive end portions of respective pickets (Examiner considers the portion of the internal wall (20) between the apertures (22) to be flanges).

As to Claim 13. Souza, Jr. discloses the pickets being fastened to the rail by a deformed portion (33) of each picket within the rail.

As to Claim 25. Souza, Jr. discloses a pair of rails (Fig 14) which support the pickets.

As to Claim 26. Souza, Jr. discloses a panel for a fence having at least one hollow rail (16) and a plurality of pickets (31) supported by the rail, wherein the pickets enter the rail by passage through respective entry apertures (Fig 3) in the rail, and a portion of

each picket located inside of the rail is transversely flattened (33) to thereby prevent further passage of the pickets through the respective entry apertures (Fig 14).

It is noted that the method as to how the pickets are deformed and the time in which the pickets are deformed impart no additional structural limitations to the claimed structure. The specific method of forming is not germane to the issue of patentability of the device itself. See MPEP § 2113.

As to Claim 28. Souza, Jr. discloses each picket passes through only one side of the rail and ends within the rail (Fig 14).

Claims 1, 3, 24, 26 and 29 are rejected under 35 U.S.C. 102(b) as being anticipated by Summers (US Patent 6,088,902).

As to Claim 1. Summers discloses a panel (Fig 1) for a fence having at least one hollow rail (11) and a plurality of pickets (10) supported by the rail, wherein each picket passes through two apertures in the rail (12; Fig 2), and a portion (13) of each picket located inside of the rail between the apertures is deformed while within the rail to thereby prevent further passage of the pickets through apertures (Figs 4-5).

As to Claim 3. Summers discloses the portion (13) of each picket that has been deformed within the rail has a partly flattened shape that no longer matches the shape of the respective apertures in the rail (Fig 5).

As to Claims 24 and 29. Summers discloses each picket passes through opposite sides of the rail and has an end portion outside of the rail (Fig 2).

As to Claim 26. Summers discloses a panel for a fence having at least one hollow rail (11) and a plurality of pickets (10) supported by the rail, wherein the pickets enter the rail by passage through respective entry apertures (12) in the rail, and a portion of each picket located inside of the rail is transversely flattened (Figs 4-5) while within the rail to thereby prevent further passage of the pickets through the respective entry apertures (Fig 5).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Souza Jr. in view of Peach et al (US Patent 2,614,827).

Souza Jr. discloses wherein the portion of each picket located inside of the rail is narrowed in one direction and extended in another direction, however, does not disclose both directions being perpendicular to a longitudinal axis of the picket.

Peach et al teaches a similar assembly having a picket (120; Figs 17-18) located inside a rail (114) wherein the picket is narrowed in one direction and extended in another direction, both directions being perpendicular to a longitudinal axis of the picket (Figs 17 and 18). It would have been obvious to one of ordinary skill in the art to modify the railing system of Souza Jr. to have the picket deformed in directions perpendicular to a longitudinal axis of the picket as taught by Peach et al because such a method of deformation does not require any tools and is deformed while the picket is within the rail (Col 5, Lines 8-23).

Response to Arguments

Applicant's arguments filed 10/18/2007 have been fully considered but they are not persuasive.

As to the claims, Applicant argues:

"The pickets in Souza pass through only one aperture in each rail" (Page 6)

Examiner respectfully disagrees. As advanced above, Examiner considers the first aperture to be the elongated aperture defined by the rail body 16 and the second aperture to be the holes 22. Therefore the prior art satisfies the limitations as set forth by the claim language.

Applicant additionally argues:

"The stems 33 in Souza are deformed by hammering before each of the rails is assembled whereas the rails of amended claim 1 can be formed by a crimping tool which extends through a completely contained or formed rail" (Page 6)

Examiner respectfully disagrees and notes that the method as to how the pickets are deformed and the time in which the pickets are deformed impart no additional structural limitations to the claimed structure. The specific method of forming is not germane to the issue of patentability of the device itself. See MPEP § 2113.

Applicant additionally argues:

"The pickets 62 of claim 1 can have two spaced points of contact with the corresponding rail 60, 63 rather than only one as disclosed in Souza to form a more stable connection." (Page 6)

Examiner respectfully points out that there is no limitation within the claims requiring the pickets to have two spaced points of contact with the rail. Applicant misinterprets the principle that claims are interpreted in the light of the specification. Although these elements are found as examples or embodiments in the specification, they were not claimed explicitly. Nor were the words that are used in the claims defined in the specification to require these limitations. A reading of the specification provides no evidence to indicate that these limitations must be imported into the claims to give meaning to disputed terms. Constant v Advanced Micro-Devices Inc. 7 USPQ 2d 1064.

Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. In re Van Geuns, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant finally argues:

“Souza does not include an internal wall or any internal structure that may be considered an internal wall. The wall 20, asserted by the Examiner to be the internal wall, in Souza is an external wall that includes an entry aperture. The wall 20 cannot be considered both the external wall and the internal wall” (Page 7)

Examiner respectfully disagrees. As advanced above, Examiner considers the first aperture to be the elongated aperture defined by the rail body (16) and the second aperture to be the holes (22) defined by the internal wall (20). The wall is considered an “internal” wall because it is located and fixed to the rail within the rail's periphery, hence, internal with relationship to the outer surface of the rail. Therefore the prior art satisfies the limitations as set forth by the claim language.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US Patents 1070814, 1114486, 1234674, 1236185, 1791680, 2614827, 3244406, 3522933, 3822053, 4146212, 4451025, 6254064 and US Patent Application Publications 2006/0214149 and 20070015390 showing similar fences.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joshua T. Kennedy whose telephone number is (571) 272-8297. The examiner can normally be reached on M-F: 7am - 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on (571) 272-7087. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JTK
11/16/2007



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